

REMARKS / DISCUSSION OF ISSUES

Claims 1-10 are pending in the application.

The applicants thank the Examiner for acknowledging receipt of the claim for priority, and the receipt of all priority documents. The applicants also thank the Examiner for notifying the applicants that the drawings are acceptable.

The Office action rejects claims 1-3, 5-6, 8, and 10 under 35 U.S.C. 102(b) over Himmel et al. (USP 6,208,995, hereinafter Himmel). The applicants respectfully traverse this rejection.

MPEP 2131 states:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 1, upon which claims 2-5 and 10 depend, claims a method that includes determining if the document is present within a sub-collection of the collection that is determined based on an application located on an information carrier. Claim 6, upon which claims 7-9 depend, includes a similar limitation.

Himmel fails to teach a collection that is **determined based on** an application located on an information carrier.

The Office action asserts that because Himmel's application may be stored on an information carrier, and because Himmel's application allows a user to select a set of allowable websites, this necessarily implies that Himmel teaches determining a sub-collection of a collection based on the application. The applicants respectfully disagree with this assertion.

Himmel's application allows a user to select any set of bookmarks as an allowable collection/sub-collection. An allowable sub-collection cannot be **determined** from Himmel's application. Himmel's allowable websites are **solely**

determined by the user's selection of the set. Given that any user may select any set of web-sites using Himmel's application, the **determination** of the allowable websites is not **based on** Himmel's application, because Himmel's application, per se, provides no information that would enable one to **determine** any particular collection of websites.

The applicants respectfully maintain that the Examiner's rationale obviates the terms 'determined' and 'based on' in the applicants' claims. Consider, for example, the fact that Himmel's application is executed on a particular user's computer. The applicants respectfully maintain that one could not reasonably assert that, because the computer that is executing the application allows a user to select the set of allowable websites, the collection is determined based on the user's computer. However, following the rationale provided in the Office action, the collection would be determined based on the user's computer, which is obviously contrary to the phrase 'determined based on'. The applicants respectfully maintain that the Examiner is considering the phrase '**determined based on**' to be equivalent to the phrase '**selected by using**', and such equivalence is not grammatically, technically, nor logically supportable.

Because Himmel fails to teach determining a sub-collection based on an application on an information carrier, as specifically claimed in claims 1 and 6, upon which all of the other claims depend, the applicants respectfully maintain that the rejection of claims 1-3, 5-6, 8, and 10 under 35 U.S.C. 102(b) over Himmel is unfounded, per MPEP 2131, and should be withdrawn.

The Office action rejects claims 4, 7, and 9 under 35 U.S.C. 103(a) over Himmel and Metz et al. (USP 5,768,539). The applicants respectfully traverse this rejection.

MPEP 2142 states:

"To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) **must teach or suggest all the claim limitations**... If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

Claim 4 is dependent upon claim 1 and claims 7 and 9 are dependent upon claim 6. In this rejection, the Office action relies upon Himmel for teaching the elements of claims 1 and 6. As noted above, Himmel does not teach the elements of claims 1 and 6. Accordingly, the applicants respectfully maintain that the rejection of claims 4, 7, and 9 over 35 U.S.C. 103(a) that relies upon Himmel for teaching the elements of claims 1 and 6 is unfounded, per MPEP 2142, and should be withdrawn.

In view of the foregoing, the applicants respectfully request that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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